

REMARKS:

Claims 10-12

Claims 10, 11 and 12 have been objected to under 37 CFR 1.75 as being substantial duplicates of claims 3, 6 and 7, respectively. Applicants believe that the amendments to claims 10-12 have obviated the rejection.

Claims 1, 6, 8, 11

Claim 1 has been rejected under 35 USC 102(e) as being anticipated by Sakakima et al. (US6567246).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 1-5, 7-10 and 12 prior to the effective date of Sakakima (Mar. 1, 2000). Per MPEP 706.02(b), Applicant may overcome a 35 U.S.C. 102(e) rejection by showing completion of the invention by applicant prior to the effective date of the reference. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 8 based on Sakakima.

Regarding claims 6 and 11, the limitations of claims 6 and 11, while not specifically shown in Exhibit A of the accompanying Declaration, would have been obvious to one skilled in the art, as evidenced by the disclosure of depositing the various layers in Exhibit A of the attached Declaration. In the present case, it was well known to use in beam sputtering to form thin film structures at the time the disclosure in Exhibit A was created. As noted in MPEP 706.15, even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. However, the affidavit or declaration showing must still establish possession of the

invention (i.e., the basic inventive concept) and not just of what one reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).

In the instant case, the basic inventive concept is fully disclosed in the accompanying Declaration. Claims 6 and 11 merely define methods of deposition known at the time of invention. Accordingly, the limitations of claims 5 and 6 are believed to be inherently present in Exhibit A of the attached Declaration, and thus predate Sakakima.

Claim 2

Claim 2 has been rejected under 35 USC 103(a) as being anticipated by Sakakima.

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claim 2 prior to the effective date of Sakakima (Mar. 1, 2000). Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 2 based on Sakakima.

Claims 2-5, 9 and 10

Claims 2-5, 9 and 10 have been rejected under 35 USC 103(a) as being anticipated by Sakakima in view of Sato (US5986858).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 2-5, 9 and 10 prior to the effective date of Sakakima (Mar. 1, 2000). Per MPEP 715.02, Applicants may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by Applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 2-5, 9 and 10 based in part on Sakakima.

Claims 7 and 12

Claims 7 and 12 have been rejected under 35 USC 103(a) as being anticipated by Sakakima in view of Pinarbasi (US5871622).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 7 and 12 prior to the effective date of Sakakima (Mar. 1, 2000). Per MPEP 715.02, Applicants may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by Applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 7 and 12 based in part on Sakaima.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. IBM1P088).

Respectfully submitted,

By: /Dominic M. Kotab/

Dominic M. Kotab
Reg. No. 42,762

Date: May 11, 2006

Zilka-Kotab, PC
P.O. Box 721120
San Jose, California 95172-1120
Telephone: (408) 971-2573
Facsimile: (408) 971-4660